UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**.　　2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-29_ is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-29_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

　　a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: ____ .

DETAILED ACTION

Claims 1-29 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs

of 35 U.S.C. 102 that form the basis for the rejections under

this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for
patent by another filed in the United States before the invention thereof
by the applicant for patent, or on an international application by another
who has fulfilled the requirements of paragraphs (1), (2), and (4) of
section 371(c) of this title before the invention thereof by the applicant
for patent.

The changes made to 35 U.S.C. 102(e) by the American

Inventors Protection Act of 1999 (AIPA) and the Intellectual

Property and High Technology Technical Amendments Act of 2002 do

not apply when the reference is a U.S. patent resulting directly

or indirectly from an international application filed before

November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the

amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-2, 10-11, 15-16, 20-21, 25-29 are rejected under 35

U.S.C. 102(e) as being anticipated by Grapes US (6446130).

As per claim 1, Grapes teach a method for preparing graphical

content associated with corresponding digital audio content,

comprising (abstract):

receiving said graphical content associated with said

corresponding audio digital content from a digital database

[col. 3, lines 9-13 and col. 3, lines 66 to col. 4, line 9]; and

preparing said graphical content for packaging with said

corresponding digital audio content (col. 4, lines 2-13) by

implementing at least one format conversion [col. 5, lines 40-

58].

As per claim 2, Grapes teach the method according to claim 1,

wherein said receiving step comprises downloading said graphical

content from said digital database in a format compatible with a

first commercial software program [col. 3, lines 9-13 and col.

5, lines 22-39].

As per claim 10, Grapes teach an apparatus for preparing

graphical content associated with corresponding digital audio

content comprising:

means for receiving said digital graphical content [col. 3, lines 9-13 and col. 3, lines 66 to col. 4, line 9]; and

means for preparing said digital graphical content by implementing at least one format conversion [col. 4, lines 2-13 and col. 5, lines 40-58].

As per claim 11, Grapes teach the apparatus according to claim 10, wherein said means for receiving said digital graphical content comprises a personal computer executing a first software application [col. 3, lines 3-13].

As per claim 15, Grapes teach an apparatus for preparing graphical content associated with corresponding digital audio content comprising:

a first module receiving said graphical content [col. 3, lines 9 to col. 4, line 9]; and

a second module preparing, said graphical content for packaging with said corresponding digital audio content by implementing at least one format conversion [col. 4, lines 2-13 and col. 5, lines 22-58].

As per claim 16, Grapes teach the apparatus according to claim 15, wherein said first module comprises a first software program [col. 3, lines 9-13].

As per claim 20, Grapes teach an interactive data conversion system comprising:

a digital database, said digital database including graphical content and corresponding digital audio content [col. 3, lines 9-13 and col. 3, lines 66 to col. 4, line 9];

a first server coupled to the digital database and hosting a website via which a user can access the digital database [col.5, lines 22-51];

a personal computer coupled to the first server via a public computer network, said personal computer including [col.5, lines 22-39]:

a first module receiving said graphical content associated with said corresponding digital audio content[col. 3, lines 66 to col. 4, line 9 and col.5, lines 22-51]; and

a second module preparing the graphical digital content for packaging with the corresponding audio digital content by

implementing at least one format conversion [col. 4, lines 2-13 and col. 5, lines 22-58].

As per claim 21, Grapes teach the apparatus according to claim 20, wherein said first module comprises a first software program [col. 3, lines 9-13 and col. 5, lines 22-39].

As per claim 25, Grapes teach a method for transmitting media to a consumer over a public computer network comprising:

transmitting a digital media file over the computer network to a user's personal computer in response to user's request for the digital media file [col. 3, lines 29-67 and col.5, lines 22-51]; and

transmitting a graphics file associated with the digital media file to the user's personal computer over the computer network [col.4, lines 2-13 and col.5, lines 22-51].

As per claim 26, Grapes teach the method according to claim 25, further comprising receiving the digital media file and the graphics file at the user's personal computer [col.4, lines 2-13 and col.5, lines 22-51].

As per claim 27, Grapes teach the method according to claim 26,

further comprising converting the graphics file to a printable

format after receiving it [col.3, lines 41-48].

As per claim 28, Grapes teach the method according to claim 26,

further comprising storing the digital media file on a computer

readable medium [col.3, lines 9-13].

As per claim 29, Grapes teach the method according to claim 28,

further comprising printing the graphics file and attaching the

printed graphics to the computer readable medium [col.3, lines

9-55].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which

forms the basis for all obviousness rejections set forth in this

Office action:

> (a) A patent may not be obtained though the invention is not identically
> disclosed or described as set forth in section 102 of this title, if the
> differences between the subject matter sought to be patented and the prior
> art are such that the subject matter as a whole would have been obvious at
> the time the invention was made to a person having ordinary skill in the
> art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

Claims 3-9, 12-14, 17-19 and 22-24 are rejected under 35 U.S.C.

103(a) as being unpatentable over Grapes US (6446130) in view of

Kolling et al US (6385595).

As per claims 3-5, although Grapes shows substantial features of

the claimed invention, he does not explicitly show using a

commercial software program such as Quark Xpress and Acrobat

Distiller.

Nonetheless, these applications are well known in the art

and would have been an obvious modification of the system

disclosed by Grapes, as evidenced by Kolling et al USPN.

(6385595).

In analogous art, Kolling et al whose invention is about

preparing electronic statement that includes audio, video,

graphics and custom enclosure, disclose template authoring

system that utilizes of-the-shelf software such as Quark Xpress

and Acrobat Distiller for manipulating and creating templates

[Col. 9, lines 53 to col. 10, line 25].

Giving the teaching of Kolling et al, a person of ordinary

skill in the art would have readily recognized the desirability

and the advantage of modifying Grapes by employing the

commercially available software packages taught by Kolling et

al for their ubiquitous use in desktop publishing and printable

materials.

As per claim 6, Kolling et al teach the method according to

claim 1, wherein said at least one format conversion comprises

converting said digital graphical content into postscript files

and converting said postscript files into PDF files [col. 10,

lines 11-25].

Regarding claim 7 as modified, Kolling et al teach the method

according to claim 1, wherein said at least one format

conversion comprises:

utilizing a first software program to manipulate said

digital graphical content [Col. 9, lines 53-67]:

creating postscript files corresponding to said digital

graphical content [Col. 10, lines 11-25];

manipulating said postscript files corresponding to said

graphical content utilizing a second software program [Col. 9,

lines 53-67]:

creating PDF files corresponding to said digital graphical

content [Col. 10, lines 11-25]; and

Grapes as modified teaches printing said (PDF) files[col. 3, lines 41-48].

As per claim 8, Kolling et al teach the method according to claim 7, wherein said first software program includes Quark Xpress [Col. 10, lines 11-25].

As per claim 9, Kolling et al teach the method according to claim 7, wherein said second software program includes Acrobat Distiller [Col. 10, lines 11-25].

As per claim 12, Kolling et al teach the apparatus according to claim 11, wherein said first software application includes Quark Xpress [Col. 10, lines 11-25].

As per claim 13, Kolling et al teach the apparatus according to claim 10. wherein said means for preparing said digital graphical content comprises a personal computer executing at least one of two software applications [Col. 10, lines 11-25].

As per claim 14, Kolling et al teach the apparatus according to claim 13, wherein said two software applications include Quark Xpress and Acrobat Distiller [Col. 10, lines 11-25].

As per claim 17, Kolling et al teach the apparatus according to claim 16, wherein said first software program includes Quark Xpress [Col. 10, lines 11-25].

As per claim 18, Kolling et al teach the apparatus according to claim 16, wherein said second module comprises a second software program [Col. 10, lines 11-25].

As per claim 19, Kolling et al teach the apparatus according to claim 18, wherein said second software program includes Acrobat Distiller [Col. 10, lines 11-25].

As per claim 22, Kolling et al teach the apparatus according to claim 21, wherein said first software program includes Quark Xpress [Col. 10, lines 11-25].

As per claim 23, Kolling et al teach the apparatus according to

claim 20, wherein said second module comprises second software

program [Col. 10, lines 11-25].

As per claim 24, Kolling et al teach the apparatus according to

claim 23, wherein said second software program includes Acrobat

Distiller [Col. 10, lines 11-25].

Conclusion

The prior made of record and not relied upon is considered

pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier

communications from the examiner should be directed to Yasin

Barqadle whose telephone number is 703-305-5971. The examiner

can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are

unsuccessful, the examiner's supervisor, Glenn Burgess can be

reached on 703-305-9717. The fax phone numbers for the

organization where this application or proceeding is assigned

are 703-872-9306 for regular communications and 703-746-7238 for

After Final communications.

Any inquiry of a general nature or relating to the status

of this application or proceeding should be directed to the

receptionist whose telephone number is 703-305-3900.

Yasin Barqadle

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